

REMARKS

Claims 21 to 29 and 31 to 34 are pending in this application. All of the claims have been rejected. By this amendment, Applicant has canceled claims 25, 27, 31 and 34 without prejudice; and amended claims 21 and 28. No new matter has been added, full support for the amendments being found in the specification and drawings as filed. Entry of the amendments is respectfully requested.

In view of the above amendments and the following remarks, Applicant respectfully submits that this application is in condition for allowance. Accordingly, reconsideration and a timely Notice of Allowance are respectfully requested.

The Present Invention

The present invention is directed to a novel and nonobvious method for managing intellectual property rights in an intellectual property arising from one or more contract documents. The present invention, according to an embodiment, provides an intellectual property rights management method using a computer based interface to pose questions designed to elicit critical information about intellectual property rights, answered by those who have the best understanding of the rights acquired, to allow authorized individuals to determine the scope and extent of their holdings. The method comprises the steps of: packaging at least one contract document and pertinent legal questions pertaining to the intellectual property, directing the review of the at least one contract document and pertinent legal questions, acquiring responses to the pertinent legal questions,

and storing the acquired responses in a database to permit searching of the acquired responses.

Rejections Under 35 U.S.C. §112, First Paragraph

The Examiner rejected claims 21 to 29 and 31 to 34 under 35 U.S.C. §112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with the which it is most nearly connected to make and/or use the invention. Applicants have canceled claims 25, 27, 31 and 34 without prejudice, but respectfully traverse this rejection as to the remaining claims.

In particular, the Examiner states that it is unclear from the disclosure how the computer would be programmed, without undue experimentation to convert text and essay questions and responses into computer data in order to take into account all of the subjective answers which the process appears to entail. Additionally, the Examiner states that the specification lacks guidance on how to use the data in maximizing use of the assets. The Examiner's rejection has been carefully considered, but is respectfully traversed.

As explained in the specification and drawings as filed, for example in paragraphs 81 and 155, the electronic questionnaires can allow answers to be placed on the form, such as by typing in text fields on the form, as well as by selecting from pull-down boxes and radio buttons listing possible answer choices. Additionally, a legal opinion may be attached directly

to the questionnaire. The answers are then gathered from the form and placed in a searchable database.

Applicant respectfully submits that one skilled in the art can program a computer to take the answers and place them in a searchable database without undue experimentation. Applicant notes that the responses can be predetermined values from radio boxes and pull down menus, as described in paragraphs 81 and 155, or text entered in specific areas of the questionnaire, all of which can be placed in a searchable database without undue experimentation.

Once the database is populated, the data can be used to maximize use of the assets. As explained in paragraphs 172 to 177 of the specification, searches can be conducted to determine, for example, all of the possible rights associated with different project types and all properties that have distribution rights in specific foreign territories.

That answers can be taken and placed in a searchable database by one skilled in the art without undue experimentation is shown in Martin (U.S. Patent No. 6,330,547), which was cited by the Examiner. In Martin, information is collected "in an automated fashion using a scanning device or may be collected from a secure Internet website based on entries made directly by the applicant". Col. 4, lines 50 to 53. Also, the data may be answers to questionnaires prepared by the user in advance, and direct input of documents containing the information. Col. 5, lines 63 to 66.

Therefore, Applicant respectfully requests that the rejection of remaining claims 21 to 24, 26, 28, 29, 32 and 33 under 35 U.S.C. §112, first paragraph be withdrawn.

The Examiner rejected claims 31 and 34 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner states that the added limitations of wherein the step of directed the review further comprises prompting selection of one or more special format answers, wherein the one or more than one contract document and the pertinent legal questions are sent via e-mail and the responses are received via e-mail, wherein the emails are encrypted and compressed, and wherein the step of routing the package for review further comprises prompting selection of one or more special format answers from pull-down boxes or radio buttons do not have sufficient disclosure in the specification and therefore constitute new matter.

Applicants have canceled claims 31 and 34 without prejudice, but have added the limitations of claims 31 and 34 to claims 21 and 28 respectively. Accordingly, Applicant addresses this rejection as to claims 21 and 28. The Examiner's rejection has been carefully considered, but is respectfully traversed.

Claim 21, as amended, recites that "the step of directing the review further comprises prompting selection of one or more special format answers." Claim 28, as amended, recites that "the step of routing the package for review further comprises prompting selection of one or more special format answers from pull-down boxes or radio buttons." Applicant respectfully submits that full support for these limitations are found in the

specification and drawings as filed, for example in paragraph 155 and Fig. 31. Paragraph 155 states:

"As shown in Fig. 31, some questions may have special format answers, for example requiring listing of territories or media. In such case, pull-down boxes listing possible choices, radio buttons, or similar programming techniques may be used to reduce error in entry and constrain the reviewer into a select group of choices. Additionally, optionally where answers are dependent and mutually exclusive, pull-down boxes and the like may be constrained to prevent inconsistent responses, or to allow branching to appropriate sub-parts."

The other limitations mentioned by the Examiner, namely "wherein the one or more than one contract document and the pertinent legal questions are sent via email and the responses are received via email, wherein the emails are encrypted and compressed" are not found in claims 31 and 34, but rather in claims 32 and 33 which were not rejected under 35 U.S.C. §112, first paragraph. However, full support for these limitations is found in the specification and drawings as filed, for example, in paragraph 141. Paragraph 141 is directed to an embodiment where the recipient has access to secure electronic mail through the Internet and states:

"The routing module then assembles the one or more than one contract document 12, and hierarchical tree 60 into intellectual property package 98, compresses the package if desired using available compression techniques, encrypts the package if desired using available encryption techniques, and transmits the package to the recipient."

As explained in paragraph 159, the package with the responses can be electronically routed back. Therefore,

Applicant respectfully submits that full support for the limitations of claims 32 and 33 are found in the specification and drawings as filed.

Applicant submits that no new matter was added by the addition of the above limitations to claims 21 and 28 or by the addition of claims 32 and 33. Accordingly, Applicant respectfully requests that this rejection be withdrawn, and that no corresponding rejection be made to any of claims 21, 28, 32 and 33.

Rejections Under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 31 and 34 under 35 U.S.C. §112, second paragraph as being indefinite. In particular, the Examiner states that it is not clear what the applicant means by the step of directing the review further comprises prompting the selection of one or more special format answers. Applicant has canceled claims 31 and 34 without prejudice, but has amended claims 21 and 28 to recite the limitations of claims 31 and 34 respectively.

As explained in paragraph 155, and shown in Figs. 31 and 32 of the specification, special format answers, may include for example, pull-down boxes listing possible choices, radio buttons or similar programming techniques may be used to reduce error in entry and constrain the review into a select group of choices. Additionally, where answers are dependent and mutually

exclusive, pull-down boxes may be used to prevent inconsistent responses or to allow branching to appropriate sub-parts.

Thus, Applicant respectfully submits that the limitation of "prompting selection of one or more special format answers" in claims 21 and 28, as amended, is fully described in the specification, such that the language would be definite to one skilled in the art.

Therefore, Applicant respectfully requests that the rejection of claims 31 and 34 under 35 U.S.C. §112, second paragraph be withdrawn.

Rejections Under 35 U.S.C. § 101

The Examiner rejected claims 21 to 29 and 31 to 34 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant has canceled claims 25, 27, 31 and 34 without prejudice, but respectfully traverses this rejection as to the remaining claims.

In particular, the Examiner states that claims 21 to 24, 26, 28, 29, 32 and 33 do not produce a "concrete" result. Applicant respectfully disagrees. As explained in MPEP §2106, the expansive language of 35 U.S.C. §101 includes "anything under the sun that is made by man." Patents may be obtained on any new and useful machine, manufacture, composition of matter or a process. Claims 21 to 29 are directed to a new and useful process. The present invention is not drawn to non-statutory descriptive material such as abstract ideas, laws of nature or natural phenomena.

The present invention leads to the creation of a searchable database of interrelated intellectual property rights. Insufficient attention to rights management may result in the loss of millions of dollars or revenue opportunities and the loss of the intellectual property itself. The methods of the present invention enhance the ability of a person or business to exploit and protect its intellectual property assets. Therefore, Applicant respectfully submits that the claimed methods fall under the broad umbrella of 35 U.S.C. §101.

Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 21, 22, 26, 27 and 31 under 35 U.S.C. § 102 as being anticipated by Rivette et al. (U.S. Patent Publication No. US 2003/0046307). Applicant respectfully disagrees with the Examiner. However, in the interest of advancing prosecution, Applicant has canceled claims 25, 27 and 31 without prejudice, and amended claim 21 to include the limitations of claims 25 and 31. Claim 25 was not subject to this rejection and Applicant respectfully submits that the incorporation of the limitations of claim 25 into claim 21 render this rejection moot. Remaining Claims 22 and 26 depend from claim 21.

Additionally, while the Examiner rejected claim 31 under 35 U.S.C. § 102 as being anticipated by Rivette et al., the Examiner did not provide any detailed basis for that rejection.

Accordingly, the Examiner provided no detailed basis for rejecting the limitations of claim 31 now recited in claim 21.

Accordingly, Applicant respectfully requests that the rejection of remaining claims 21, 22, and 26-27 be withdrawn.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 23 to 25 and 28 to 30 under 35 U.S.C. § 103 as being unpatentable over Rivette et al. (U.S. Patent Publication No. US 2003/0046307) in view of Martin (U.S. Patent No. 6,330,547). Applicant has canceled claim 30, but respectfully traverses this rejection with regard to the remaining claims. Additionally, because Applicant amended claim 21 to incorporate the limitations of claim 25, Applicant addresses this rejection as to all of the pending claims.

The Examiner states that Rivette et al. fail to teach or suggest questionnaires, as recited in claims 21, 23, 24 and 28 and cites to Martin to remedy the defects of Rivette et al. However, Applicant respectfully submits that Martin fails to remedy the defects of Rivette et al.

Martin is directed to a method and apparatus for deciding whether to make a loan using an intangible asset, such as intellectual property. Martin discloses that data, including answers to questionnaires prepared by the user in advance may be entered into a computer. However, Martin provides no detail about the questionnaires. Accordingly, Applicant respectfully submits that Martin fails to teach or suggest questions "designed to elicit critical information about ownership rights in intellectual property" as recited in claim 21. Additionally,

Applicant respectfully submits that Martin fails to teach or suggest "preparing a package having one or more than one rights questionnaire" as recited in claim 28. Accordingly, Applicant respectfully submits that claims 21 and 28 are patentable over Rivette et al. and Martin, taken alone and in combination.

Additionally, claim 21 has been amended to recite the limitations of claim 31 that "wherein the step of directing the review further comprises prompting selection of one or more special format answers"; and claim 28 has been amended to recite the limitations of claim 34 that "wherein the step of routing the package for review further comprises prompting selection of one or more special format answers from pull-down boxes or radio buttons."

Applicant respectfully submits that these limitations have not been specifically rejected in view of any prior art. Applicant further submits that neither Rivette et al. nor Martin teach or suggest these limitations. Finally, Applicant submits that special format answers, such as pull-down boxes and radio buttons are particularly advantageous in that special format answers reduce error in data entry and constrain the review to a select group of choices. Additionally, where answers are dependent and mutually exclusive, pull-down boxes may be used to prevent inconsistent responses or to allow branching to appropriate sub-parts. Accordingly, Applicant respectfully submits that claims 21 and 28 are patentable over Rivette et al. and Martin, both alone and in combination.

Claims 22 to 24, 26, 29, 32 and 33 depend from claims 21 and 28 and by definition contain all of the limitations of

claims 21 and 28. Accordingly, Applicant respectfully submits that claims 22 to 24, 26, and 29 are patentable over Rivette et al. and Martin for the reasons given above for claims 21 and 28, as well as because of the additional limitations contained therein.

Additionally, Applicant respectfully submits that one skilled in the art would have no motivation to combine the features of Martin and Rivette et al. The Examiner states that it would have been obvious to one of ordinary skill in the art incorporate into the patent information management method of Rivette et al., the questionnaires taught in Martin so as to guide the user to provide the complete data necessary to perform an analysis. However, the questionnaires taught in Martin only relate to the identity and financial and legal status of a loan applicant. Applicant respectfully submits that the identity and financial and legal status of a loan applicant is irrelevant to the system and method of Rivette et al. which is unconcerned with loan applications. Therefore, one skilled in the art would have no motivation to combine Martin and Rivette et al.

Therefore, Applicant respectfully requests that this rejection be withdrawn.

The Examiner rejected claims 32 and 33 under 35 U.S.C. §103(a) as being unpatentable over Rivette et al. In view of the amendments to claim 21, Applicant respectfully traverses this rejection. As explained, above, claim 21 has been amended to include the limitations of claim 25 and 31. The Examiner stated that Rivette et al. do not teach or suggest choice of rights questionnaires, as recited in amended claim 21.

Accordingly, as explained above, claim 21 is patentable over Rivette et al. Claims 32 and 33 depend from claim 21 and by definition contain all of the limitations of claim 21. Accordingly, Applicant respectfully submits that claims 32 and 33 are patentable over Rivette et al.

Therefore, Applicant respectfully requests that this rejection be withdrawn.

CONCLUSION

In view of the above amendments and remarks, Applicant respectfully submits that this application is in condition for allowance. Therefore, reconsideration and a timely indication of allowance are respectfully requested. If the Examiner believes a telephone conference would aid in the prosecution of this application, then the Examiner is invited to contact the undersigned, or Marc Karish (Reg. No. 44,816) at the below listed telephone number.

A fee of \$1020 is believed due for a three month extension of time. Additionally, a fee of \$790 is believed due for the Request for Continued Examination filed herewith. The Commissioner is hereby authorized to charge payment of these fees and any other fees associated with this communication to Deposit Account No. 19-2090.

Respectfully submitted,
SHELDON MAK ROSE & ANDERSON PC

Dated: May 14, 2007

By /Robert J. Rose/
Robert J. Rose
Registration No. 47,037

Sheldon Mak Rose & Anderson PC
100 E. Corson St., 3rd Fl.
Pasadena, CA 91103-3842
626-796-4000